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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 827,440	04/06/2001	James M. Thommes	ITW 7188C	6197

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CORRIGAN LAW OFFICE
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APPLETON, WI 54915

EXAMINER

SHAW, CLIFFORD C

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,440

Applicant(s)

THOMMES, JAMES M.

Examiner

Clifford C Shaw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 25-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 6) ☐ Other:

Detailed Action

1.) The specification is objected to. In his preliminary amendment, applicant refers to a new figure 6 which is "a block diagram of an alternative embodiment". Applicant is advised that the originally filed drawings do not include a figure 6. Further, the "Transmittal of Corrected Application Papers (Drawings)" filed on 6/11/2001 did not include a figure 6. Applicant is to resolve this issue. If applicant submits a new figure, he is cautioned against introducing new matter into the application.

2.) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.) Claims 25-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,239,407, claims 1-23 of U.S. Patent No. 6,002,103, and claims 1-24 of U.S. Patent No. 5,601,741. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are broader in scope than the patented claims and are therefore

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obvious over the patented claims. If applicant responds to this rejection with a terminal disclaimer, **this terminal disclaimer is to be directed to all three of the above mentioned patents**

4.) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.) Claims 36 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 36, there is no antecedent basis for the converter. Claim 42 depends from itself, making it unclear what subject matter the claim is directed to.

6.) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.) Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Turbitt (3,025,388). The claim is broad enough to read on figure 9 of the patent to Turbitt. In figure 9 of Turbitt, the converting of an ac input from 14 is done by transformer 15 and variable inductors 17 (which "converts" its input voltage to an output voltage), the power factor correcting is done

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by elements 19-22, and the rectifier 23 changes the ac from the power factor correction into a current suitable for welding, as claimed.

8.) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9.) Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Turbitt. The only aspect of the claim to which the rejection above does not apply is the provision for "providing control signals to the converter". This difference does not patentably distinguish over the prior art. It is considered obvious that the power supply of Turbitt includes an on/off switch and this switch would clearly constitute the source of a "control signal" for the power supply of Turbitt. Alternatively, the variable reactors 17 in Turbitt could obviously be adjusted based on a user control and thus obviously constitute control signals to the converter.

10.) Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turbitt as applied to claim 34 above, and further in view of Karino et al. (5,343,017, cited by applicant). It would have been obvious to have provided the power supply shown in figure 9 of Turbitt with an auxiliary power source and with a pulse width modulated inverter, the motivation being the

teachings of Karino et al. that it is advantageous to provide a welding power source with an auxiliary supply (see element 22 in figure 3 of Karino et al.) and with a pulsed width controlled inverter (see elements 14 and 9 in figure 3 of Karino et al.), thereby satisfying the claims.

11.) Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Turbitt or Karino et al. (5,343,017, cited by applicant). Either one of Turbitt or Karino et al. discloses a power supply for making a weldment. It is considered obvious that the power supplies of either one of Turbitt or Karino et al. could produce a weldment indistinguishable from the weldment claimed by applicant since the "process" part of the product by process claim 45 does not include any limitation that would uniquely determine a specific characteristic of a welded workpiece. Since the weldment of claim 45 has no uniquely determined characteristic, the claim obviously reads on a weldment produced by any other power supply, including those of Turbitt or Karino et al.

Any inquiry concerning this communication should be directed to Clifford C Shaw at telephone number 703-308-1712. The examiner can normally be reached on Monday through Friday of the first week of the pay period and on Tuesday through Friday of the second week of the pay period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas G. Dunn, can be reached at 703-308-3318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Clifford C Shaw
Primary Examiner
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September 27, 2002